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EXAMINER

O'CONNOR, GERALD J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/523,079
Filing Date: March 10, 2000
Appellant(s): Gerhardt

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GROUP 3600

Patrick R. Scanlon
(Reg. No. 34,500)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal filed September 15, 2003 (Paper No. 14).

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(Assignee of record, *General Electric Company*.)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(Claims 1-3, 6-9, and 12 are pending, rejected, and appealed.)

(Claims 4, 5, 10, and 11 are cancelled.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(No amendment after final has been filed.)

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct:

- I. Whether or not *apparatus* claims 1-3 and 6 are unpatentable under 35 U.S.C. 102(a) for being anticipated by *Harrington* (US 5,895,454).
- II. Whether or not *method* claims 7-9 and 12 are unpatentable under 35 U.S.C. 103(a) for being obvious over *Harrington* (US 5,895,454).

(7) Grouping of Claims

Appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant fails to offer any explanation as to why the claims of each group are believed to be *separately patentable*, as required by 37 CFR 1.192(c)(7), which states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellant's arguments merely point out differences in the claims, which is *not* an argument as to why the claims are *separately patentable*, as explicitly set forth by rule in 37 CFR 1.192(c)(7).

Therefore, for purposes of appeal, *apparatus* claims 1-3 and 6 should stand or fall together as Group I and *method* claims 7-9 and 12 should stand or fall together as Group II, since appellant's brief does not include *both* a statement that these groupings of claims do not stand or fall together *and* (valid) reasons in support thereof.

However, notwithstanding the deficiency of appellant's brief with respect to grouping of claims, the entirety of appellant's arguments have nevertheless been fully considered and addressed hereinbelow, including appellant's separate arguments directed solely to additional elements recited in various dependent claims.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The prior art of record relied upon in the rejection of claims under appeal is as follows:

5,895,454

Harrington

4/1999

(10) *Grounds of Rejection*

I. Apparatus claims 1-3 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by *Harrington* (US 5,895,454).

Harrington discloses a network-based parts distribution system comprising:

a plurality of buyer computers 11 for operation by a system participant desiring to obtain one or more parts (see, for example, the abstract and Figures 1 and 2);

a plurality of seller computers 12 for operation by a system participant desiring to sell one or more parts (see, for example, the abstract and Figure 1); and,

at least one server computer 20 (see, for example, Fig. 2 and the top left of Fig. 1);
wherein said buyer computers, said seller computers, and said server computer are interconnected as a computer network (see, for example, the abstract and Figures 1 and 2);
wherein said server computer being programmed to receive part (product) related data from seller computers (see, for example, column 4, lines 8-12) and use said data to maintain a database 10 of all available parts (products) and to receive part (product) requests from said buyer computers and select one or more parts (products) from said database in response to said requests (see, for example, the abstract and column 2, lines 51-58);
wherein said parts (products) in said database are sorted into a plurality of inventory categories (see, for example, column 5, lines 35-36); and,
wherein said parts (products) in at least one of said inventory categories are further sorted into a plurality of sub-inventory categories (see, for example, column 5, lines 38-40).

Note that the functional claim limitation regarding basing the sub-inventory categories upon particular non-functional descriptive material, in this case, "part condition," has been deemed merely an intended usage of the claimed apparatus, thus afforded little patentable weight, since the structure of the apparatus of *Harrington* is certainly inherently capable of performing the claimed usage/function, as the sellers can readily enter into the system any particular non-functional descriptive material they desire in order to accurately describe the parts being sold (e.g., "new widgets," "used widgets," "factory-reconditioned widgets," etc.).

Regarding claim 2, the server computer of the parts distribution system of *Harrington* selects parts (products) in a buyer-specific picking order (since a specific/particular buyer is doing the selecting of their parts by doing the picking/clicking during the online shopping/browsing/ purchasing session).

Regarding claim 3, the server computer of the parts distribution system of *Harrington* relays a purchase order 34 issued by one of said buyer computers to an appropriate one of said seller computers (see, for example, the last five lines of the abstract, as well as column 2, lines 51-58).

Regarding claim 6, the computer network of the parts distribution system of *Harrington* is the Internet (see, for example, column 1, lines 6-14).

II. Method claims 7-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Harrington* (US 5,895,454).

Harrington discloses a method of distributing parts, said method comprising the steps of:

providing a plurality of buyer computers 11 for operation by a system participant desiring to obtain one or more parts (see, for example, the abstract and Figures 1 and 2);

providing a plurality of seller computers 12 for operation by a system participant desiring to sell one or more parts (see, for example, the abstract and Figure 1);

providing at least one server computer 20 (see, for example, Figure 2 and the top left of Figure 1);

wherein said buyer computers, said seller computers, and said server computer are interconnected as a computer network (see, for example, the abstract and Figures 1 and 2);

using said seller computers to input part (product) related data to said server computer (see, for example, column 4, lines 8-12);

using said data to maintain a database 10 of all available parts (products) (see, for example, the abstract and column 2, lines 51-58);

said step of maintaining said database including sorting said parts (products) in said database into a plurality of inventory categories (see, for example, column 5, lines 35-36);

using said buyer computers to transmit part (product) requests to said server computer (see, for example, the abstract and column 2, lines 51-58); and,

selecting one or more parts (products) from said database in response to said requests (see, for example, the abstract and column 2, lines 51-58).

Harrington also discloses the step of further sorting the parts in at least one inventory category into a plurality of sub-inventory categories (see, for example, column 5, lines 38-40), but does not specifically disclose that these further sub-inventory categories could be based upon part condition.

However, parts having different part conditions, and being listed for sale in accordance with their respective part conditions, such as “new,” “used,” and “factory-reconditioned,” or “excellent,” “good,” and “fair,” etcetera, is a well known, hence, obvious method step to follow in listing parts for sale, since the values of parts in different conditions would be expected to differ, thus sell for different prices.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of *Harrington* of further sorting the parts in at least one inventory category into a plurality of sub-inventory categories, so as to do so based upon part condition, as is well known to do for parts being sold, in order to allow purchasers more flexibility in purchasing parts by allowing the purchasers to spend more or less for a part, based on the purchaser's requirements for acceptable condition, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 8, in the method of *Harrington* the step of selecting one or more parts from the database includes selecting parts (products) according to a buyer-specific picking order (since a specific/particular buyer is doing the selecting of their parts by doing the picking/clicking during the online shopping/browsing/ purchasing session).

Regarding claim 9, the method of *Harrington* further comprises the step of using said server computer to relay a purchase order 34 issued by one of said buyer computers to an appropriate one of said seller computers (see, for example, the last five lines of the abstract, as well as column 2, lines 51-58).

Regarding claim 12, the computer network in the method of *Harrington* is the Internet (see, for example, column 1, lines 6-14).

(11) Response to Argument

I. Apparatus claims 1-3 and 6 are Anticipated by *Harrington* (Issue I).

Regarding the argument that the database 10 of *Harrington* is not a database of all available parts (e.g., page 5, lines 16-17) because database 10 only “provides information relating to remote vendor websites on which a user can find products or services for sale” (e.g, page 5, lines 18-19), the database 10 indeed provides information relating to remote vendor websites on which a user can find products or services for sale, thus the database 10 of *Harrington* is indeed a database of all available parts/products.

The invention of *Harrington* comprises, “methods and apparatus for allowing a user to view, order, and pay for products and/or services using the world wide web” (see, for example, column 1, lines 11-12). The user enters the product specifications for a product or service into a query of the database 10 and the database 10 returns a list of links to vendors

who sell that part or that service so that the user can pick one from which to purchase/order the desired part or service. Thus, the database 10 is a “database of all available parts,” since, for example, if a part was not available (i.e., was not for sale by any one of the vendors) the database would not return any vendors in the list of vendors that have the part available for sale, and, if the part was available for sale at three vendors, the database 10 would return a list comprising the three vendors that had the desired part available for sale.

To the extent that appellant is arguing that the disclosure of *Harrington* refers to the objects/things being ordered as “products,” whereas the claim language refers to the objects/things being ordered as “parts,” it is the finding of the examiner, as trier-of-fact, that one of ordinary skill in the art of Internet ordering/e-commerce systems would recognize the terms “parts” and “products” as synonymous terms of art for denoting the objects/things being ordered (along with several other terms, including any of: “items,” “goods,” “merchandise,” “articles,” “commodities,” “inventory,” and “sundries,”).

Furthermore, it is well settled that *during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow*¹, as well as that, with regard to the particular names/words/terms used by a reference, that *the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory*².

¹ *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

² *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding the argument that “the database 10 [of *Harrington*] pertains to remote vendor websites and is not intended to identify specific parts that are available for sale” (e.g., page 5, lines 23-24), identifying specific parts that are available for sale is the express and primary purpose of the database 10 of *Harrington*, as the invention of *Harrington* comprises, “methods and apparatus for allowing a user to view, order, and pay for products and/or services using the world wide web” (see, for example, column 1, lines 11-12). *Harrington* additionally discloses that one of the advantages of her invention over the known prior art of the time is that “selection can be made on the basis of a users particular requirements” (column 2, lines 6-7), which is advantageous over previous systems because, without her invention, “if a user merely wishes to browse for a particular product ... the only practical way is to carry out a search of the web using one of the available search engines. However, such search facilities are not effective in discriminating commercial from non-commercial sites and it may be very difficult to narrow a search sufficiently so that non-vendor sites are excluded and vendor sites satisfying desired criteria are identified” (column 1, line 61, thru column 2, line 3).

Regarding the argument that “database 10 is not a collection of data that identifies specific parts that are actually available for sale [because only] after connecting to one or more of the websites is a user able to find and purchase products or services that are actually available for sale” (e.g., page 6, lines 7-10), database 10 is most certainly a collection of data that identifies specific parts that are actually available for sale, since that is its express purpose,

as the invention of *Harrington* comprises, “methods and apparatus for allowing a user to view, order, and pay for products and/or services using the world wide web” (see, for example, column 1, lines 11-12). Clearly, the parts listed are “available for sale.” The database specifically identifies where they are available for sale (at what website). The fact that the user must connect to one or more of the websites to purchase a desired part is completely irrelevant, since no recitation of the claims precludes the user purchasing the part(s) in such a manner.

Regarding the argument that “the user would have to connect with all of the websites to find all of the available products” (e.g., page 6, lines 10-12), the statement is utterly false, as the user could find all of the available parts/products without connecting to any of the websites, as the database that contains the list of all available products, and where they are available, is the database 10 that the user queries. According to *Harrington*, “The database 10 would contain information (represented as information originating from vendor 32) relating to vendor products, locations, website addresses, price, maps, etc. A user 11 would (after connecting to the database machine) specify particular criteria which would be used by the database search engine 21 to provide a list of suitable websites which match the users product/service criteria.” (column 4, lines 9-16). So, the user can “find” all of the available parts/products in the database 10, without connecting to any other website, which is the point/object of the invention of *Harrington*.

Regarding the argument that *Harrington* “does not disclose that parts in the database 10 are sorted into a plurality of inventory categories, and the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition, as required by claim 1” (e.g., page 6, lines 15-18), the parts (products) in the database 10 are indeed sorted into a plurality of inventory categories (see, for example, column 5, lines 35-36), and the parts (products) in at least one of said inventory categories are further sorted into a plurality of sub-inventory categories (see, for example, column 5, lines 38-40).

To the extent that appellant is arguing that the intended usage of the apparatus of claims 1-3 and 6 is to allegedly perform a different method than had previously been performed, *the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art*³.

To the extent that appellant is arguing that the functional language recited in apparatus claims 1-3 and 6 recites method steps not comprised by the admitted prior art, *claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function*,⁴ as *apparatus claims cover what a device is, not what a device does*⁵. Moreover, a claim containing

³ *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

⁴ *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

⁵ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim⁶.

To the extent that appellant is arguing that the particular material or article worked upon by the apparatus of apparatus claims 1-3 and 6 differs from the particular material or article that had been worked upon in the prior art apparatus, *expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim⁷*. Furthermore, *inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims⁸*.

Therefore, for all of these reasons, the functional claim limitations drawn to basing the sub-inventory categories upon particular non-functional descriptive material, in this case, "part condition," has been deemed merely intended usage of the claimed *apparatus*, thus afforded little patentable weight, since the structure of the apparatus of *Harrington*, as configured, arranged, and programmed, is certainly inherently capable of performing the claimed usage/ function without need of any modification or reprogramming, as the sellers can readily enter into the system whatever particular non-functional descriptive material they desire in order to describe the parts being sold (e.g., "new widgets," "used widgets," "factory-reconditioned widgets," etc.).

⁶ *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

⁷ *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

⁸ *In re Young*, 25 USPQ 69 (CCPA 1935), as restated in *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding the argument that *Harrington* “does not disclose a server computer programmed to select one or more parts from a database in response to buyer requests, as required by claim 1” (e.g., page 7, lines 19-21), *Harrington* clearly discloses a server computer 20 programmed to select one or more parts from a database 10 in response to buyer requests, as required by claim 1, since that is the express purpose of the system of *Harrington*, as the invention of *Harrington* comprises, “methods and apparatus for allowing a user to view, order, and pay for products and/or services using the world wide web” (see, for example, column 1, lines 11-12). Note too, that in searching the database 10 of *Harrington*, the search terms can be broad (e.g., “Ford” or “Ford Mustang”) or narrow, such as a particular part number (e.g., “50012345”), and the results returned will be broad or narrow, accordingly.

Regarding the argument that *Harrington* fails to disclose “a server computer selecting parts according to a buyer-specific picking order” (e.g., page 8, lines 4-5) as required by claim 2, while it is true that the *absence of any claimed element from a reference negates anticipation*⁹, an anticipatory reference can *disclose the claimed subject matter either expressly or inherently*¹⁰. *A reference which is silent about a claimed invention’s features is inherently anticipatory if the missing feature is necessarily present in that which is described in the*

⁹ *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

¹⁰ *Constant v. Advanced Microwave Devices, Inc.*, 7 USPQ2d 1057 (Fed. Cir. 1988).

*reference*¹¹. Moreover, *a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention*¹².

As the server computer of the parts distribution system of *Harrington* must necessarily, thus inherently, selects part (products) in a buyer-specific picking order, since a specific/ particular buyer is the one doing the selecting of their parts by doing the picking/clicking during the online shopping/browsing/ purchasing session, claim 2 is therefore anticipated by *Harrington*.

Regarding the argument that *Harrington* fails to disclose “a server computer relaying a purchase order from a buyer to a seller” (e.g., page 8, line 8) as required by claim 3, the server computer of the parts distribution system of *Harrington* relays a purchase order 34 issued by one of said buyer computers 11 to an appropriate one of said seller computers 12, since, “at the conclusion of a local users shopping session, the user” (i.e., the buyer 11) “confirms the selection(s) whereby the database and associated database interface” (i.e., the server computer 20) “transmits purchase/ordering data” (i.e., a purchase order 34) “to the remote vendor sites” (i.e., the appropriate one(s) of the seller computers 12) “corresponding to the users selection” (last five lines of the abstract). See also, column 2, lines 51-58.

¹¹ *In re Robertson*, 49 USPQ2d 1999 (Fed. Cir. 1999), *In re Oelrich*, 212 USPQ 323 (CCPA 1981).

¹² *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

II. Method claims 7-9 and 12 are Obvious over *Harrington* (Issue II).

Regarding the argument that there “is no suggestion in the prior art of record to provide the system of *Harrington* with a database of parts instead of a database of information relating to remote vendor websites” (e.g., page 9, lines 3-5), no suggestion is needed since no modification is needed, because the database of *Harrington* indeed comprises a database of parts, as discussed at length hereinabove.

Regarding the argument that *Harrington* “fails to disclose sorting the parts in a database into a plurality of inventory categories, wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition” (e.g., page 9, lines 13-16) because *Harrington* “does not teach sorting parts into a plurality of inventory categories” (page 9, lines 20-21), *Harrington* certainly teaches sorting the parts in the database 10 into a plurality of inventory categories, as well as further sorting the categories into sub-categories (see, for example, column 5, lines 35-40).

Regarding the argument that the examiner “contends that sorting an inventory of a particular type of part into a plurality of sub-inventory categories based on part condition is a well known, obvious method step” (e.g., page 10, lines 1-3), the examiner has made no such contention, thus the argument is irrelevant. The only contention of the examiner as to what is

well known is that it is well known to list/include in the description of an item for sale the condition of the item being sold (e.g., “new,” “used,” etc.).

The sorting of the parts in a database into a plurality of inventory categories, wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories is explicitly disclosed by *Harrington* (see, e.g., column 5, lines 35-40).

Regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be “well known” prior art (e.g., page 10, lines 5-7), the argument has been disregarded as merely spurious, since challenging the existence of well known prior art by merely arguing that the fact is not supported by a reference, without stating for the record that the examiner is wrong or that applicant is without knowledge of the prior art teaching, does not constitute a proper traversal of the finding(s).

Furthermore, whereas appellant has failed to seasonably provide any proper traverse to the examiner’s stated position(s) as to what is well known prior art, and, as any further traversal (proper or not) would no longer be considered seasonable, the object(s) of the well known statement(s) are therefore now deemed and considered henceforth to be admitted prior art. See MPEP § 2144.03.

Regarding the argument that there is no suggestion to combine the prior art references (e.g., page 10, line 8-15), the examiner recognizes that *obviousness can only be established by*

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art^{13, 14}.

In this case, the knowledge generally available to one of ordinary skill in the art would include selling parts of various conditions, such as “new” and “used” parts, and indicating/ including in the non-functional descriptive material describing the item/part/product/thing for sale, the particular condition of the part being sold in order to accurately describe the thing being sold so that customers would be able to ascertain a particular, accurate, and appropriate value for the item.

Furthermore, to the extent that appellant is attempting to argue that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that *any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper¹⁵.*

¹³ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

¹⁴ *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

¹⁵ *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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September 23, 2004

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